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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,420	09/21/2000	Mariko Okamoto	07336.0003-00000	8873

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

FUBARA, BLESSING M

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/667,420	<b>Applicant(s)</b> OKAMOTO ET AL.	
	<b>Examiner</b> Blessing M. Fubara	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10 and 18-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10 and 18-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Examiner acknowledges receipt of request for extension of time and remarks filed 10/26/04. Claims 1-4, 6-10 and 18-41 are pending.

#### ***Claim Rejections - 35 USC § 103***

1. Claims 1-4, 6-10 and 18-41 remain rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-021227 and Cernasov et al. (US 5,976,510).

- a) Applicants argue that the Examiner failed to point to evidence of suggestion or motivation in either of the cited references to modify the composition disclosed in the JP reference by including the perfluoroalkyl phosphate treated pigments of Cernasov in order to arrive at the presently claimed invention. Applicants further state that Examiner fails to point to any evidence of expectation of success.
- b) Applicants argue that Cernasov does not disclose a gelling agent and specifically Cernasov does not disclose specific polyacrylamide based polymer gelling agent as claimed in the present invention, and that Cernasov discloses the use of perfluoroalkyl phosphate treated pigments with particular emulsion with specific dispersants.
- c) Applicants argue that Cernasov discloses that it is the combination of perfluoroalkyl phosphate treated pigment with dispersants and selected oily phase that leads to high moisture content for the skin and not the perfluoroalkyl phosphate treated pigment itself that leads to high moisture content for the skin, and thus Examiner's allegation of suggestion is incorrect.
- d) Applicants state that when the fluorine compound is used with gelling agent other than the one recited in instant claim 1, the resulting composition does not have

Art Unit: 1615

satisfactory characteristics of stable gel formation and good lasting effects and sense of application on the skin and that the 132 declaration of 03/05/04 shows that.

2. Applicants' arguments filed 10/26/04 have been fully considered but they are not persuasive.

a) The idea of combining JP 11-021227 and Cernasov flows logically from two compositions that have been individually taught in the prior art. And "it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose..." In *re* Kekhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

The combination of the JP reference and Cernasov is expected to succeed as a cosmetic composition that would effectively provide excellent moisture retention characteristic.

b) Applicants in b) above argue against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

c) Applicants' claim 1 is generic to a composition that comprises and because it comprises, the composition can have other ingredients such as that disclosed by Cernasov. Although, Cernasov's composition that leads to high moisture content for the

Art Unit: 1615

skin is a combination of perfluoroalkyl phosphate treated pigment with dispersants and selected oily phase, the composition of Cernasov that is a cosmetic contains perfluoroalkyl phosphate treated pigment and that composition leads to high moisture content for the skin. And, although, applicants argue against the references individually, and although one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references, it is noted here again that *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) applies.

d) The JP reference discloses a polyacrylamide based gelling agent in the cosmetic composition. The gel composition of the JP reference also contains pigments and fillers. Thus, forming a third composition from combination of the two composition is expected to be effective for use for the very same purpose, and in this case as a cosmetic.

The 132 declaration:

The 132 declaration compares the composition of Cernasov, compositions 2, 3 and 8 with composition 1, the inventive composition. Applicants by this compare the individual composition of Cernasov with the inventive composition and by so doing is attacking the individual Cernasov reference and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Secondly, the composition 4 of the declaration is the individual composition of the JP reference and applicants compare composition 4 with the inventive composition 1. In this case, applicants attack references individually where the rejections are based on combinations of references. The declaration does not compare the combined composition of the JP reference and Cernasov with the inventive

Art Unit: 1615

composition. Thus applicants failed to show that the composition of Cernasov cannot be combined with the JP composition. Applicants failed to compare the combined composition of the JP reference and Cernasov with the inventive composition.

Therefore, the instant composition is not inventive over the combined composition of JP and Cernasov in the absence of a showing. On page 3 of the last office action it was stated that “applicants’ 132 declaration does not give data on how the instant composition and the composition of the prior art affect the skin.” The composition of the prior art is the combined composition of the JP reference and Cernasov. The rule 132 declaration was filed 03/05/04 and receipt is acknowledged.

No claim is allowed.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1615

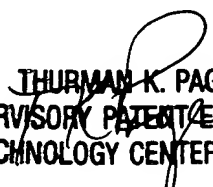
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Blessing Fubara  
Patent Examiner  
Tech. Center 1600

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600